



Expedited Procedure
Group Art Unit: 3623

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

R. Gloor et al.

Serial No: 09/439,310

Filed: 11/12/99

Title: BUSINESS METHOD FOR
QUALITY ASSURANCE OF
SERVICES

Group Art Unit: 3623

Examiner: J. Reagan

Docket No. END919990079US1

IBM Corporation
Intellectual Property Law
Department N50/040-4
1701 North Street
Endicott, NY 13760

Patricia Lewis
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9-23-02

AMENDMENT/RESPONSE

Assistant Commissioner of Patents
Washington, DC

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Dear Sir:

In response to an office action dated 07/15/2002 in the above-designated application, Applicants offer the following response which is filed within two months of the date of the Office Action:

A formal drawing is provided along with a letter to the Official Draftsperson.

Claim 4 stands rejected under 35 U.S.C. 101 as directed to non-statutory subject matter. Applicants respectfully disagree and offer the following argument.

Dependent claim 4 limits a step of independent claim 1. Specifically the step of performing a first readiness review step to identify new issues..., determine whether delivery plans are

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established, and establish baselines... is limited by limiting the determining whether delivery plans are established clause to examine whether written delivery plans comprising... are all established.

Claims 1 and 4 are method claims to a business process, which is clearly allowable subject matter. The step of claim 1 as further limited by claim 4 is clear and definite. A meeting is conducted to examine whether written delivery plans are all established. The result of this examination is then used in the next step of claim 1, specifically, periodically performing a project management review. As stated in Applicants' Specification on page 7 lines 32-34, the frequency of performing this next step may depend on the results of the first readiness review step which is the step limited by claim 4.

The steps are clear and one could repeat the examination to determine whether all written delivery plans are established and then use the results of the examination in setting the frequency of the project management reviews of claim 1.

Claim 4 stands rejected under 35 U.S.C. 112 second paragraph as being indefinite. Although claim 4 itself does not recite what one would expect to gain from the examination, claim 4 is dependent on claim 1 and includes all of the steps of claim 1. In particular claim 4 includes the step of periodically performing a project management review. As noted above, the frequency of these reviews may depend on the results of the examination performed in claim 4. Claim 4 therefore is definite.

Applicants respectfully request withdrawal of the rejections of claim 4 under 35 U.S.C. 101 and 35 U.S.C. 112.

Claims 1-4 stand rejected under 35 U.S.C. 102(b) as anticipated by Eisner, "Essentials of Project and Systems Engineering Management".

Applicants maintain that Eisner does not describe all of the steps and the particular combination found in claims 1, 2, and 4.

Specifically the pages of Eisner cited by the Examiner do not describe Applicants' claim 1 step of performing a first assurance reviewed by determination of technical viability of said first solution nor describe determination of deliverability of said first solution.

Eisner pages 46-53, 157, and 160-161 describe requirements definition, confirmation that needs, goals and objectives are still current, and analysis of alternatives to select a preferred system architecture. While these activities may support defining a first solution step, none of these describe all of the requirements noted above in Applicants' step of performing a first assurance review.

Claim 1 also requires performing a second assurance review having 4 business items. Although Eisner may describe Life-Cycle Costing and budgeting and scheduling constraints, Eisner does not describe all 4 requirements of applicants' second assurance review. These are specifically whether said first solution

includes complete schedules, a complete cost and profit case, whether said first solution satisfies both said provider business objectives and said customer need. Eisner therefore does not describe Applicants' step of performing a second assurance review.

Claim 1 also requires performing a first readiness review of said second solution to ... establish baselines for performance and profit. A baseline is defined on Applicants' page 7 lines 26-27 as a measure of the expected level based on the second solution plans.

Eisner in his Figure 7.3, page 155, in box 9 has "Recompose and refine baseline concept". While the word baseline appears in box 9, this step describes a baseline concept, which is not Applicants' baselines for performance and profit as required by Claim 1 in light of Applicants' specification. Eisner therefore does not describe each and every element of Applicants readiness review step.

Because Eisner does not describe Applicants' steps of performing a first assurance review, nor performing a second assurance review, nor performing a first readiness review, rejection of claim 1 under 35 U.S.C. 102(b) should be withdrawn. Applicants respectfully request such withdrawal. Claim 1 is allowable.

Claims 2 and 4 depend directly on allowable claim 1 and are therefore also allowable.

The Application is deemed in condition for allowance and such action by the Examiner is urged. Should differences remain, however, which do not place one/more of the remaining claims in condition for allowance, the Examiner is requested to phone the undersigned at the number provided below for the purpose of providing constructive assistance and suggestions in accordance with M.P.E.P. Sections 707.07 (j) and 707.03 in order that allowable claims can be presented, thereby placing the Application in condition for allowance without further proceedings being necessary.

Respectfully submitted,



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